



**UNITED STATES DEPARTMENT OF COMMERCE**  
**Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/938,989	09/26/97	LAUNDER	30456.00.017

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PM51/0521

EXAMINER
BATSON, V

ART UNIT	PAPER NUMBER
3671	

DATE MAILED: 05/21/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
08/938,909

Applicant(s)

LAUNDER ET AL.

Examiner

VICTOR BATSON

Group Art Unit

3671



☒ Responsive to communication(s) filed on Mar 2, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-32 and 64-78 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-32 and 64-78 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☒ The proposed drawing correction, filed on Mar 2, 1999 is ☒ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

***Decision On Petition To Correct Originally Named Inventors***

This is a decision on the petition under 37 C.F.R. § 1.48(a) to correct the incorrect naming of inventors regarding patent application 08/938,909.

The petition requests that the Brian L. Launder be deleted as an inventor of the invention disclosed in the above-identified patent application.

A grantable petition under 37 C.F.R. § 1.48(a), must be accompanied by the required fee pursuant to 37 C.F.R. § 1.17(I) and an oath or declaration in support of the petition meeting the following requirements.

**§ 1.48 Correction of inventorship in a patent application, other than a reissue application.**

- (a) If the inventive entity is set forth in error in an executed § 1.63 oath or declaration in an application, other than a reissue application, and such error arose without any deceptive intention on the part of the person named as an inventor in error or on the part of the person who through error was not named as an inventor, the application may be amended to name only the actual inventor or inventors. When the application is involved in an interference, the amendment must comply with the requirements of this section and must be accompanied by a motion under § 1.634. Such amendment must be accompanied by:

- (1) A petition including a statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part;
- (2) An oath or declaration by the actual inventor or inventors as required by §1.63 or as permitted by §1.42, § 1.43 or § 1.47;
- (3) The fee set forth in § 1.17(i); and
- (4) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b)).

The petition does not meet the requirements for special status inasmuch as the corroborating affidavits lacks a statement from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part as set forth under 37 C.F.R. 1.48(a)(1).

Therefore, the petition is **DENIED**.

Should applicant desire reconsideration, he/she should supplement this petition by a declaration or statement under oath giving the information as outlined above. No further petition fee is required.

Any request for reconsideration must be filed within TWO MONTHS of the date of this decision.

***Amendment filed March 2, 1999***

1. The amendment to page 24 line 1 "same line, change "exemplification" to --exemplifications--;" was not entered because "exemplification" was found on page 24 line 1. Clarification is required.

***Drawings***

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: Reference number "376" (page 22 line 22). Correction is required.

***Specification***

3. The disclosure is objected to because of the following informalities: On page 23 lines 19-22, the sentence beginning "As will be appreciated ... is not understood, and specifically, the phrase "the fore-and-aft spaced of pairs" is confusing. Additionally, it appears that there should be a comma or some punctuation between "adapter 312" & "tooth 314" on page 23 line 22. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

4. Claims 26 & 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 26 line 6 & claim 28 line 7,

"the forces" lacks proper antecedent basis as it is unclear whether applicant is referring to "vertical forces" or "lateral forces" established in claim 23.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. Claims 1-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Clendenning (5,765,301).

Clendenning discloses an excavation tooth assembly comprising an adapter 12 having a horizontal land section through which a bore extends with a vertical wall 46, with a tooth having a cavity adapted to mate with the adapter, with the cavity configured with a recess defining a substantially horizontal transmitting section through which a hole extends to act in conjunction with the bore of the adapter, the tooth further having a vertical wall corresponding to the vertical wall of the land section, with a fastener 18 as shown in figure 1.

Concerning claim 26, Clendenning discloses a horizontal forward land section and a substantially horizontal forward transmitting

section (at 38). Additionally, Clendenning in figures 1, 3,4 shows three generally parallel support surfaces.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 64,67,68,71,72 are rejected under 35 U.S.C. 102(b) as being anticipated by Hahn (4,727,663).

Hahn discloses all of applicants claimed structure of an excavating tooth comprising an elongated wedge shaped member defining a pair of axially aligned holes, the wedge shaped member further having a blind cavity opening including upper and lower tapered surfaces with each tapered surface having a rearwardly disposed substantially horizontal transmitting section defined by a recess in the tapered surfaces of the blind cavity and through which one of said holes extends as shown in figure 1. Hahn further discloses an adapter 14 comprising an axially elongated member defining a longitudinal axis and a pair of outer tapered surfaces having a rearwardly disposed substantially horizontal land section further having a bore intersecting the horizontal land sections as shown in figure 1.

9. Claims 64-78 are rejected under 35 U.S.C. 102(b) as being anticipated by Cornelius (5,272,824).

Cornelius discloses all of applicants claimed structure of an excavating tooth comprising an elongated wedge shaped member defining a pair of axially aligned holes, the wedge shaped member further having a blind cavity opening including upper and lower tapered surfaces with each tapered surface having a rearwardly disposed substantially horizontal transmitting section defined by a recess in the tapered surfaces of the blind cavity and through which one of said holes extends as shown in figures 1 & 2.

Cornelius further discloses an adapter 14 having all of applicant's claimed structure of an axially elongated member defining a longitudinal axis and a pair of outer tapered surfaces converging toward a forward end with each tapered surface having a rearwardly disposed substantially horizontal land section defined by a projection, with said member further having a bore defining an axis extending generally normal to and intersecting with the horizontal land sections as shown in figures 1 & 2

#### **Conclusion**

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art of record discloses various excavating tooth assemblies.



***Response to Arguments***

11. Applicant's arguments filed 3/2/99 have been fully considered but they are not persuasive regarding the rejection of claims 1-32 under 35 U.S.C. 102(e) as being anticipated by Clendenning (5,765,301) since the petition to correct inventorship has been denied. The examiner notes that a successful change of inventorship could however lead to a double patenting rejection.

***Final Rejection***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the

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statutory period for reply expire later than SIX MONTHS from the date of this final action.

**Inquiries**

13. Any inquiry concerning this communication should be directed to Examiner Victor Batson whose telephone number is (703) 305-6356. The examiner can be normally reached Monday through Friday (except Wednesday) from 7:00 am to 5:00 pm, Eastern Standard Time.

14. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Will, can be reached on (703) 308-3870. The fax phone number for this Group is (703) 305-7687.

May 18, 1999



Victor Batson  
Primary Examiner  
Art Unit 3671